

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GARY A. JACOBSEN

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Appeal No. 95-2346  
Application 08/147,093<sup>1</sup>

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ON BRIEF

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Before ABRAMS, FRANKFORT and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 19, which are all of the claims

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<sup>1</sup> Application for patent filed November 3, 1993. According to appellant, this application is a continuation of application serial no. 07/828,518, filed January 31, 1992, now abandoned.

Appeal No. 95-2346  
Application 08/147,093

pending in this application.

We REVERSE.

#### BACKGROUND

The appellant's invention relates to a method of manufacturing a changeable image type novelty card using an in-line offset printing and in-line finishing system (specification, page 3). An understanding of the invention can be derived from a reading of exemplary claims 1, 12 and 16 which appear in the appendix to appellant's corrected brief filed September 15, 1994.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kroner	2,311,946	Feb. 23, 1943
Bellis	2,611,201	Sep. 23, 1952
Smith	2,639,254	May 19, 1953
Cummings	4,514,248	Apr. 30, 1985
Voy et al. (Voy)	4,661,189	Apr. 28, 1987
Dean	4,697,364	Oct. 06,
1987		
Cannistra	4,938,830	Jul. 03,
1990		
Malachowski et al.	5,118,375	Jun. 02, 1992
(Malachowski)		(Filed Aug. 09, 1990)

The following rejections are before us for review:

Appeal No. 95-2346  
Application 08/147,093

(1) Claims 1 through 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dean in view of Bellis in combination with either Cannistra or Malachowski;

(2) Claims 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dean in view of Bellis in combination with either Cannistra or Malachowski, as applied in (1) above, and further in view of Kroner;

(3) Claims 8, 9 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dean in view of Bellis in combination with either Cannistra or Malachowski and Kroner as applied in (2) above, further in view of Cummings;

(4) Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Dean in view of Bellis in combination with either Cannistra or Malachowski and Kroner and Cummings as applied in (3) above, further in view of Voy.

(5) Claims 12, 15, 16 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dean in view of Bellis in combination with either Cannistra or Malachowski, as

applied in (1) above, and further in view of Smith;<sup>2</sup>

(6) Claims 13, 14 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dean in view of Bellis in combination with either Cannistra or Malachowski and Smith as applied in (5) above, further in view of Cummings;

(7) Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Dean in view of Bellis in combination with

either Cannistra or Malachowski and Smith and Cummings as applied in (6) above, further in view of Kroner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 13) and the examiner's answer (Paper No. 16) for the complete reasoning in support of the rejections, and to the

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<sup>2</sup> We call attention to a problem with the language of claim 12, para. (n), "positioning said rear panel onto said second side of said rear panel" should read --positioning said rear panel onto said second side of said front panel--. Correction of this error is in order upon return of this application to the jurisdiction of the examiner.

Appeal No. 95-2346  
Application 08/147,093

corrected brief filed September 15, 1994, for the appellant's arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is

our conclusion that the evidence adduced by the examiner is insufficient to establish a case of obviousness with respect to claims 1 through 19. Accordingly, we will not sustain the examiner's rejections of claims 1 through 19 under 35 U.S.C.

§ 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of

obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28

USPQ2d

1955, 1956 (Fed. Cir. 1993). A prima facie case of

obviousness is established by presenting evidence that the

Appeal No. 95-2346  
Application 08/147,093

reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S.

1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we turn first to the rejections of claims 1, 12 and 16, the only independent claims in the application. Appellant argues that

[t]he step of forming a strip of printable material having at least a front panel, a rear panel and an insert panel (claim 1, step c; claim 12, step c; claim 16, step c), within a continuous web of raw material for sequential processing into a novelty card is not suggested by the references. Printing on the formed strip of the web (claim 1, step d; claim 12, step e; claim 16, step f) is also not suggested by the referenced art. [corrected brief, page 16]

We agree with appellant. As evidence of obviousness, the examiner has applied Dean and Bellis in combination with either Cannistra or Malachowski against claim 1 and Dean, Bellis and Smith in combination with either Cannistra or Malachowski against claims 12 and 16.

Dean teaches a novelty card including a one piece die cut

Appeal No. 95-2346  
Application 08/147,093

envelope (11) (col. 1, lines 40-43) and an insert (12) comprising a front transparent portion (17), such as an acetate sheet,

adhered by glue along a top edge to a background portion (18) cut from thin card stock (col. 2, line 63 to col. 3, line 1).

Bellis teaches a display apparatus comprising an opaque panel (22) and a flat pocket for receiving panel (22) including a back panel or sheet (14) and a transparent front panel or sheet (18) superimposed thereon. The sheets (14) and (18) are secured along all but one edge with clips or staples. See, col. 1, line 40 to col. 2, line 3.

Cannistra teaches a method of fabricating a plastic card, e.g., a credit card, including the steps of providing a sheet (17) of plastic, printing on the rear of the sheet, preferably by offset lithography, and cutting the sheet into individual cards (col. 2, lines 24-28 and col. 4, lines 4-6).

Malachowski teaches a method and apparatus for making and filling envelopes in which an envelope sheet (2) is folded, an



insert material sheet (4) is placed in the envelope sheet and adhesive tape (12a, 12b) is placed over the ends of the envelope (col. 4, lines 21-55).

None of the four references discussed above teaches or suggests a method of forming a novelty card comprising the steps of forming a strip of printable material having at least a front

panel, a rear panel and an insert panel within a continuous web of raw material for sequential processing and printing on the formed strip of the web. Therefore, even if there were some motivation in the art for combining the teachings of Dean and Bellis with the teaching of either Cannistra or Malachowski, all of the claimed limitations of claim 1 are not taught or suggested by the applied references.

Smith teaches a method of mounting a slide or transparency using a mount composed of a pair of flap members (12, 13) and an insert (20) having opposite sides thereof coated with adhesive (col. 3, lines 9-62).

The examiner rejects claims 12 and 16 as being

unpatentable over Dean in view of Bellis in combination with either Cannistra or Malachowski, as applied against claim 1, and further in view of Smith. According to the examiner

[i]t would have been obvious to employ the teaching as set forth by Smith and adhesively bond the layers of the articles of the teachings set forth by the references in (16) above [the rejection of claim 1]. Such a combination would have been obvious as all cited references relate to process [sic] for laminating articles together. [final rejection, page 5]

Smith, like Dean, Bellis, Cannistra and Malachowski, contains no teaching or suggestion of appellant's claimed method

including the steps of forming a strip of printable material having at least a front panel, a rear panel and an insert panel within a continuous web of raw material for sequential processing or printing on the formed strip of the web. Therefore, we cannot sustain the § 103 rejections of independent claims 1, 12 and 16.

For the same reasons, the rejection of claims 2 through 5, dependent on claim 1 and rejected on the same ground as claim 1, and the rejection of claims 15 and 19, dependent on

Appeal No. 95-2346  
Application 08/147,093

claims 12 and 16, respectively, and rejected on the same ground as applied against their respective independent claim, will not be sustained.

We have also carefully considered the other references, namely, Kroner, Cummings and Voy, applied by the examiner in the various rejections of dependent claims 6 through 11, 13, 14, 17 and 18, and have concluded that none of these additional references, either alone or in combination with the other applied art, supplies the deficiencies in Dean, Bellis, Cannistra, Malachowski and Smith, noted above. Accordingly, the rejections of claims 6 through 11, 13, 14, 17 and 18 will not be sustained.

#### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1 through 19 under 35 U.S.C. § 103 is reversed.

Appeal No. 95-2346  
Application 08/147,093

**REVERSED**

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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Appeal No. 95-2346  
Application 08/147,093

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